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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,608	02/06/2004	Michael G. Fisher	021976-000200US	7771
20350	7590	06/04/2007	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP			HOFFMAN, MARY C	
TWO EMBARCADERO CENTER				
EIGHTH FLOOR			ART UNIT	PAPER NUMBER
SAN FRANCISCO, CA 94111-3834			3733	
			MAIL DATE	DELIVERY MODE
			06/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/773,608	FISHER ET AL.
	Examiner	Art Unit
	Mary Hoffman	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 14 March 2007.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-13, 15-80 and 115-121 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-13, 15-80 and 115-121 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 2/6/04, 4/12/06 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/14/2007 has been entered.

### ***Claim Rejections - 35 USC § 102***

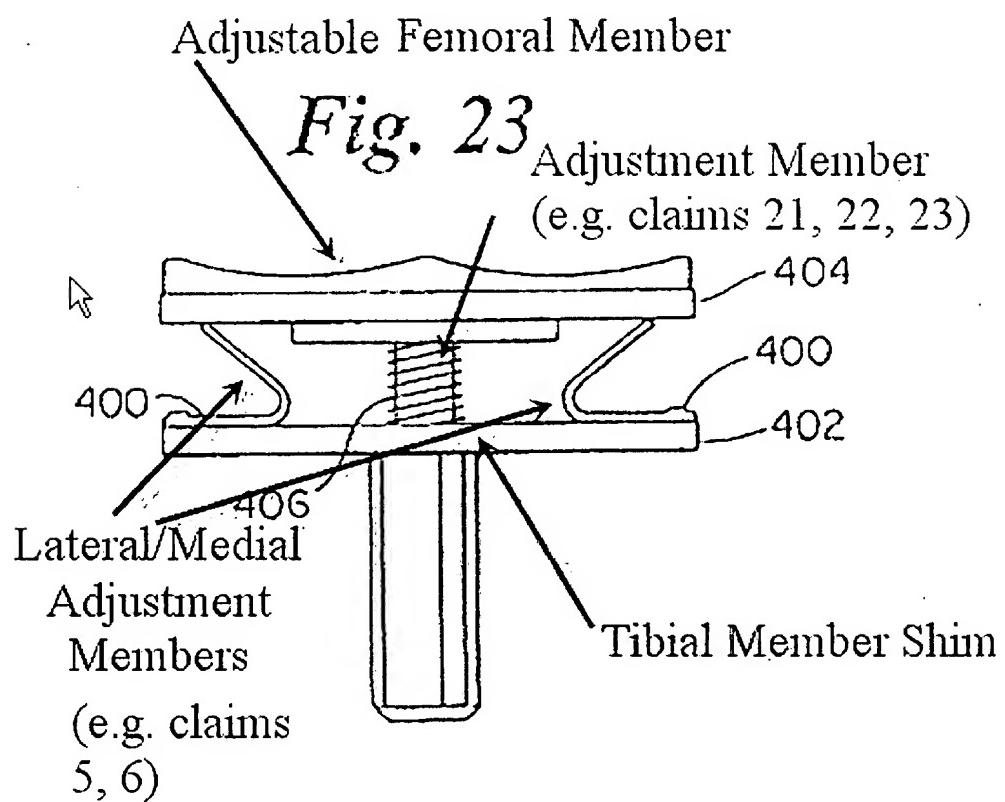
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-13, 15-19, 21-22, 26-28, 30-40, 42-54, 55-59, 61-62, 70-73, 74-80, 115-121 are rejected under 35 U.S.C. 102(b) as being anticipated by Gustilo et al. (U.S. Patent No. 5,733,292).

Gustilo et al. disclose a device comprising a stationary femoral member, an adjustable femoral member movably coupled with the stationary member that allows the knee to move through a range of motion (see Figure, next page). The adjustable member comprises an adjustment member. The adjustable member comprises a lateral adjustment member, and a medial adjustment member (see claims 5, 6). The adjustment members are springs. The adjustment member comprises a distal femoral portion and a posterior condylar portion, the posterior condylar portion comprises a

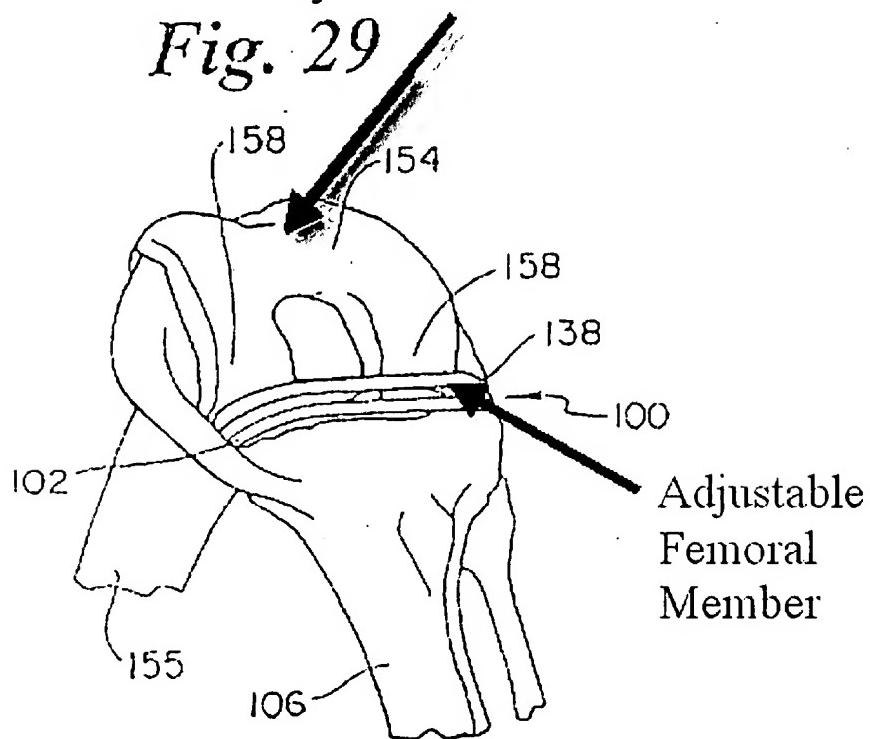
lateral and medial portion. The distal femoral portion and condylar portions comprise one piece. The stationary member comprises a distal femoral plate, and a posterior condylar member having a medial and lateral member, all comprising one piece. The adjustable femoral member comprises a self-adjusting member. The self-adjusting member comprises a spring-loaded member. The self-adjusting member adjusts relative to the stationary femoral member. The adjustment member on the adjustable member is a surface feature. The adjustable femoral member is asymmetrically oriented relative to the stationary member (see FIG. 3, col. 9, lines 42-46). The stationary member is made of a hard polymer, i.e. plastic (see col. 9, lines 59-61), and the adjustable member is made of a metal (see col. 8, lines 65-end). The device also comprises a tibial member. The tibial member comprises a shim. There can be apertures drilled asymmetrically through the members to stabilize the trial to the bone

(col. 13, lines 50-60).



Stationary Femoral Member

*Fig. 29*



Claims 1, 20-25, 28-29, 41, 60-61, 63-69 and 72 are rejected under 35

U.S.C. 102(b) as being anticipated by Gustilo et al. (U.S. Patent No. 5,733,292).

In another embodiment, Gustilo et al. disclose a device comprising a stationary femoral member, an adjustable femoral member movably coupled with the stationary member, and a tibial member that allows the knee to move through a range of motion. The adjustable member comprises a adjustment member. The adjustment member on the adjustable member is two apertures (ref. #128), and the device further comprises a grasping feature (ref. #130) coupled to the adjustable femoral member. The adjustable femoral member is asymmetrically oriented relative to the stationary member (see FIG. 3, col. 9, lines 42-46). The adjustable femoral member comprises a plurality of pre-

adjusted femoral members (see different embodiments, e.g. FIG. 1 FIG. 25, FIG. 26) having different asymmetries relative to the stationary member. The tibial member comprises a plurality of tibial members having different thicknesses or heights (see tibial members of FIG. 5 and 15). There can be apertures drilled asymmetrically through the members to stabilize the trial to the bone (col. 13, lines 50-60).

***Response to Arguments***

Applicant's arguments filed 03/14/2007 have been fully considered but they are not persuasive.

Applicant argues that the femoral component of Gustilo, ref. #154, cannot be the femoral component recited in the current claims because ref. #154 does not include adjustable or moveable portions. However, it is noted that the examiner is relying on ref. #154 as being the stationary femoral member, and not the adjustable femoral member. The stationary femoral component is not required in the claims to having any adjustable or moveable portions. Rather, the examiner is considering ref. #100 as the adjustable femoral component, and ref. #100 discloses adjustable/moveable portions. As shown in FIG. 29, the knee is flexion, and the device is capable of meeting Applicant's claimed functional limitations, since ref. #154 is clearly moveably engageable with ref. #100.

Applicant is reminded that with regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Gustilo et al., which is capable of being used as claimed if one so

desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The rejections are deemed proper.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Hoffman whose telephone number is 571-272-5566. The examiner can normally be reached on Monday-Friday 9:00-5:00pm.

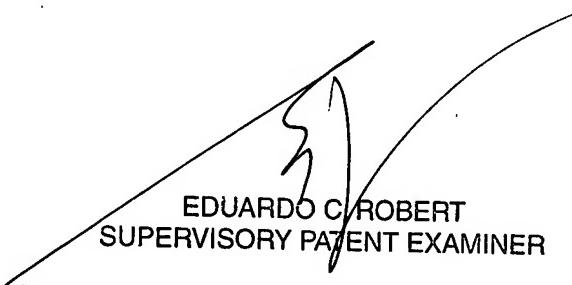
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MCH



  
EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER